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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/650,461	08/27/2003	David Dawes	10655.0025-00	7106
22852 7590 11/16/2007 FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER DUPUIS, DEREK L	
			ART UNIT 2883	PAPER NUMBER
			MAIL DATE 11/16/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/650,461

Applicant(s)

DAWES, DAVID

Examiner

Derek L. Dupuis

Art Unit

2883

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-14 and 21-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-14 and 21-23 is/are rejected.
- 7) ☐ Claim(s) 24 and 25 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 July 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>10/24/2007</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/31/2007 has been entered.

Response to Arguments

2. Applicant's arguments filed 10/31/2007 have been fully considered but they are not persuasive.

3. In pages 5 and 6, applicant argues that the prior art does not disclose the newly added claim limitation of a rare-earth doped waveguide. The examiner disagrees. Hubner et al disclose the use of rare-earth doped waveguides. Applicant recognizes this in page 9; however, applicant argues that rare earth ions doped in the waveguides of Zhou would likely be unsuccessful since Zhou used silica based glass. The examiner disagrees with this assertion. While Zhou teaches the use of silica based glass, Zhou also suggests that other glass materials could be used (see paragraph 188). Huber et al teaches in the abstract that silica can be doped with rare earth elements to enable amplification of optical signals.

4. In page 8, applicant argues that Zhou discloses only a substrate having an irregular shape. The examiner disagrees. In the preceding paragraph (paragraph 198), Zhou describes irregularly shaped waveguides.

5. In page 8, applicant also argues that obviousness was not established with regard to claim 1. Applicant argues that the examiner did not articulate a reason for obviousness. The examiner disagrees. Paragraph 7 of the rejection identifies a limitation as being notoriously well known in the art. Such a limitation alone, or in combination with other limitations taught in the art, could sustain patentability since such photodiodes are commonly used in the art in combination with other optical elements.

Information Disclosure Statement

6. The information disclosure statement (IDS) submitted on 10/24/2007 has been considered by the examiner.

Product By Process Claims

Claims 21-25 are **product-by-process claims**:

Note that a "product by process" claim is directed to the product per se, no matter how actually made, *In re Hirao*, 190 USPQ 15 at 17 (footnote 3). See also *In re Thorpe*, 227 USPQ 964, 966; *In re Luck*, 177 USPQ 523; *In re Fessmann*, 180 USPQ 324; *In re Avery*, 186 USPQ 161; *In re Wertheim*, 191 USPQ 90 (209 USPQ 554 does not deal with this issue); and *In re Marosi et al.*, 218 USPQ 289, all of which make it clear that it is the patentability of the final product per se which must be determined in a "product by process" claim, and not the patentability of the process, and that an old or obvious product produced by a new method is not patentable as a product, whether claimed in "product by process" claims or not. Note that applicant has the burden of proof in such cases, as the above case law makes clear. See also MPEP 2113.

Claims 21-25 do not distinguish over the prior art of record regardless of the process used to create the slab waveguide, because only the final product is relevant, and not the process of making such as DC-biased plasma vapor deposition.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1, 3, 7-9, and 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Zhou et al (US 2003/0044118 A1)* in view of *Hubner et al ("Planar Er- and Yb- Doped Amplifiers and Lasers")*.

9. Regarding claims 1, 7, and 9, Zhou et al teach an optical waveguide shown best in figure

13. The amorphous film based slab waveguide has a refractive index contrast of .38%. This is greater than the claimed range of 0.2%. Zhou et al teach that the core (1345) has a refractive index of 3.5 and the cladding (1350) has a refractive index of 1.7 (see paragraph 187-188). The core is disposed on a buffer layer (1310) which is disposed on a substrate (1315). As shown in figures 2-6, Zhou et al discloses that the waveguide can be coupled to a laser diode to transmit light emitted by the diode. The waveguide has a thickness sufficient to couple the light from the laser diode as shown in figures 2-6. Zhou et al teach that the waveguide could have an irregular shape which meets the limitation of having an amorphous structure. The American Heritage Dictionary defines the term "amorphous" to mean "lacking organization, formless". Irregular shapes would meet this definition.

10. Zhou et al teach that the waveguide can be formed on the same substrate as a semiconductor photonic device (see paragraph 221). Photodiodes are notoriously well known, and routinely used semiconductor photonic devices and it would be obvious to one of ordinary skill in the art to use a photodiode with an optical waveguide to detect and process an optical signal.

11. Zhou et al do not explicitly teach that the waveguide is doped with a rare-earth. Hubner et al teach that rare-earth doped waveguide are well known in the art. It would have been obvious to one of ordinary skill in the art at the time of invention to modify the device taught by Zhou et al to use a rare-earth doped waveguide as taught by Hubner et al. Motivation would be to enable the amplification of optical signals.

12. Regarding claims 3 and 8, Zhou et al in view of Hubner et al teach a device as discussed above in reference to claim 1 and claim 7. Hubner et al teach an optical waveguide device shown in figure 2a with a slab waveguide that is folded in the plane of the slab. Hubner et al also teach that the curled waveguide has a loss of 2.5 dB over 67 cm which comes out to about 0.037 dB/cm which is far less than 0.3 dB/cm. It would have been obvious to one of ordinary skill in the art at the time of invention to modify the slab waveguide taught by Zhou et al by folding it as taught by Hubner for the purpose of increasing the amplification of the waveguide. The longer the waveguide, the greater the gain. Hubner teaches that by “curling” the waveguide within an area, then a longer waveguide can be used thereby increasing the amplification of the device (see the bottom paragraph of page 72).

13. Regarding claims 21-23, Zhou et al teach an optical waveguide shown best in figure 13. The amorphous film based slab waveguide has a refractive index contrast of .38%. This is greater than the claimed range of 0.2%. Zhou et al teach that the core (1345) has a refractive index of 3.5 and the cladding (1350) has a refractive index of 1.7 (see paragraph 187-188). The core is disposed on a buffer layer (1310) which is disposed on a substrate (1315). As shown in figures 2-6, Zhou et al discloses that the waveguide can be coupled to a laser diode to transmit light emitted by the diode. Zhou et al teaches that the semiconductor laser device can be

integrated onto the same substrate as the waveguide (see paragraph 221). The waveguide has a thickness sufficient to couple the light from the laser diode as shown in figures 2-6. Zhou et al teach that the waveguide could have an irregular shape which meets the limitation of having an amorphous structure. The American Heritage Dictionary defines the term “amorphous” to mean “lacking organization, formless”. Irregular shapes would meet this definition. Claims 21-23 do not distinguish over the prior art of record regardless of the process used to create the slab waveguide, because only the final product is relevant, and not the process of making such as DC-biased plasma vapor deposition.

14. Zhou et al do not explicitly teach that the waveguide is doped with a rare-earth. Hubner et al teach that rare-earth doped waveguide are well known in the art. It would have been obvious to one of ordinary skill in the art at the time of invention to modify the device taught by Zhou et al to use a rare-earth doped waveguide as taught by Hubner et al. Motivation would be to enable the amplification of optical signals.

15. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Zhou et al (US 2003/0044118 A1)* in view of *Hubner et al (“Planar Er- and Yb- Doped Amplifiers and Lasers”)* as applied to claims 1, 3, 7-9 and 21-23 above, and further in view of *Kaneko et al (US 6,088,492)*.

16. Zhou et al in view of Hubner et al teach an optical waveguide as discussed above in reference to claim 1. Zhou et al do not explicitly state that the waveguide is smooth. Kaneko et al teach a smooth optical waveguide that is coupled to a laser diode. It would have been obvious to one of ordinary skill in the art to make the waveguide of Zhou et al in view of Hubner et al smooth as taught by Kaneko et al. Motivation to do this would be that “a smooth film surface of

an optical waveguide....is preferable for achieving a low propagation loss.” See column 3, lines 15-35 of Kaneko et al.

17. Claims 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Zhou et al (US 2003/0044118 A1)* in view of *Hubner et al (“Planar Er- and Yb- Doped Amplifiers and Lasers”)* as applied to claims 1, 3, 7-9 and 21-23 above, and further in view of *Beach (“Theory and optimization of lens ducts”)*.

18. Zhou et al in view of Hubner et al teach an optical waveguide device as discussed above in reference to claim 1. Zhou et al and Hubner et al do not teach that the slab waveguide includes a lens duct. Beach teaches a waveguide device with a lens duct to couple light from a diode into a waveguide. It would have been obvious to one of ordinary skill in the art at the time of invention to use a lens duct as taught by Beach in the waveguide device as taught by Zhou et al and Hubner et al for the purpose of “amplifying the irradiance of laser diode sources” (see abstract of Beach).

19. Claims 6, 10, 12, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Zhou et al (US 2003/0044118 A1)* in view of *Hubner et al (“Planar Er- and Yb- Doped Amplifiers and Lasers”)* as applied to claims 1, 3, 7-9 and 21-23 above, and further in view of *Medin et al (US 6,760,520 B1)*.

20. Zhou et al in view of Hubner et al teach an optical waveguide device as discussed above in reference to claim 1. Zhou et al and Hubner et al do not teach that the waveguide includes a mode-size converter or a reverse tapered region. However, Medin et al teach a mode size converter with a reverse tapered region for use in an optical waveguide device. Medin et al also teach that the mode size converter can be used in an array with an array of laser diodes and

waveguides (see column 10, line 53 to column 11, line 14). It would have been obvious to one of ordinary skill in the art at the time of invention to use the mode-size converter taught by Medin et al in the optical waveguide device of Zhou et al and Hubner et al for the purpose of improving optical coupling between a waveguide and a light emitting device (see abstract).

21. Claims 11 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Zhou et al (US 2003/0044118 A1)* in view of *Hubner et al ("Planar Er- and Yb- Doped Amplifiers and Lasers")* as applied to claims 1, 3, 7-9 and 21-23 above, and further in view of *Henrichs (US 2003/0185266 A1)*.

22. Zhou et al in view of Hubner et al teach an optical waveguide device as discussed above in reference to claim 1. Zhou et al and Hubner et al also teach that the mode size of an optical beam transmitted through the waveguide slab is smaller than the mode size of an incident light beam (see paragraphs 8-10). The field of the optical mode decreases through the waveguide. Zhou et al and Hubner et al do not teach that the diode could be a VCSEL. However, Henrichs shows that a VCSEL and a diode are equivalent structures known in the art and that they are both used in optical pumping. It would have been obvious to one of ordinary skill in the art at the time of invention to substitute a VCSEL for a laser emitting diode as a light source.

Allowable Subject Matter

23. Claims 24 and 25 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

24. The following is a statement of reasons for the indication of allowable subject matter:

25. Claim 24 is allowable over the prior art of record because the latter, either alone or in combination, does not disclose nor render obvious an optical waveguide device comprising at least one laser diode formed on a substrate and at least one amorphous film-based, biased pulsed DC plasma vapor-deposited slab waveguide having a refractive index contrast of at least 0.2% formed on the substrate, coupled to receive light from the at least one laser diode, wherein the core is formed from rare-earth doped Al_2O_3 , Y_2O_3 , or TiO_2 , and the cladding is formed from Al_2O_3 , or Y_2O_3 in combination with the rest of the claimed limitations.

26. Claim 25 is allowable over the prior art of record because the latter, either alone or in combination, does not disclose nor render obvious an optical waveguide device comprising at least one laser diode formed on a substrate and at least one amorphous film-based, biased pulsed DC plasma vapor-deposited slab waveguide having a refractive index contrast of at least 0.2% formed on the substrate, coupled to receive light from the at least one laser diode, wherein the core comprises a single-mode core and the cladding comprises a multi-mode cladding in combination with the rest of the claimed limitations.

Conclusion

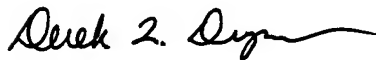
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Derek L. Dupuis whose telephone number is (571) 272-3101. The examiner can normally be reached on Monday - Thursday 8:30am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frank G. Font can be reached on (571) 272-2415. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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